

REMARKS

The Examiner has rejected claims 1, 3-7, 10-11, 13, 15, 18, 20-21, 24-25, 27 and 29 as being unpatentable under 35 U.S.C. § 103(a) over Swain (EP 1,369,099) in view of Boulanger et al. (U.S. Patent No. 4,132,618). The Examiner has also rejected claims 2, 17 and 19 as being unpatentable under 35 U.S.C. § 103(a) over Swain in view of Boulanger et al. and in further view of Baker et al. (U.S. Patent No. 3,935,085). The Examiner has also rejected claims 8 and 22 as being unpatentable under 35 U.S.C. § 103(a) over Swain in view of Boulanger et al. and in further view of Wang et al. (U.S. Patent No. 6,275,826). The Examiner has also rejected claims 12, 16, 26 and 30 as being unpatentable under 35 U.S.C. § 103(a) over Swain in view of Boulanger et al. and in further view of Moore (U.S. Patent No. 5,145,474). The Examiner has also rejected claim 31 as being unpatentable under 35 U.S.C. § 103(a) over Swain in view of Boulanger et al. and Moore and in further view of Baker. The Examiner has noted that claims 9, 14, 23, 28 and 32-33 would be allowable if rewritten in independent form.

The Applicant has carefully considered the Examiner's comments. However, Applicant respectfully disagrees with the Examiner's conclusion that the claimed invention would have been obvious in view of the prior art cited by the Examiner. 35 U.S.C. § 103 requires that the subject matter of the claimed invention be considered "as a whole." The ultimate question under 35 U.S.C. § 103 is "whether the claimed invention as a *whole* would have been obvious," "not whether the differences *themselves* [between the prior art and the claimed invention] would have been obvious." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983) (emphasis in original); *see also Schenk v. Norton Corp.*, 713 F.2d 782, 785 (Fed. Cir. 1983).

"To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

“That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art.” *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 698 (Fed. Cir. 1983).

“The ‘as a whole’ instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result—often the very definition of invention.” *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004).

“This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result—often the essence of invention.” *Princeton Biochemicals, Inc. v. Beckman Coulter*, 411 F.3d 1332, 1337 (Fed. Cir. 2005).

Contrary to the admonitions of the Federal Circuit, the Applicant contends that the Examiner has engaged in impermissible hindsight to construct Applicant’s invention piece-by-piece from the prior art using Applicant’s claims as a roadmap. Like the example given in *Ruiz v. A.B. Chance*, the Examiner has broken Applicant’s claims into component parts A and B to declare that the claims are obvious. The Examiner argues that Swain discloses an electropolishing apparatus for stents (component A). The Examiner also argues that Boulanger discloses motor driven rollers for rotating a metal tube (component B). Using hindsight and the Applicant’s claims as a roadmap, the Examiner has combined components A and B (Swain and Boulanger) in an effort to reconstruct Applicant’s claims.

However, the motivation to combine Swain and Boulanger in the manner that the Examiner has attempted is lacking. The Examiner provides no explanation for why one

of skill in the art would combine Swain and Boulanger together as the Examiner has done to achieve applicant's claimed invention. One of ordinary skill in the art would not combine Boulanger with Swain because Boulanger does not relate to the art of electropolishing medical implants. Boulanger relates to marking metallic tubes used to clad nuclear fuel elements. The size difference alone between a medical implant and a nuclear fuel rod makes it improbable that one of skill in the art would consider combining Swain and Boulanger. Moreover, Boulanger does not even relate to electropolishing. Instead, Boulanger relates to marking tubes with an identification number. Indeed, the tube that is marked (13) is not even shown immersed in the electrolytic fluid in any of the drawings. Thus, Boulanger clearly could not work to electropolish the metal tube for the nuclear fuel rod (much less a medical implant such as a stent) because electropolishing requires the device that is polished to be immersed in the electrolytic fluid. Therefore, even if one of ordinary skill in the art tried to combine Swain and Boulanger, the combination would not work to electropolish a medical implant.

A proper suggestion or motivation to combine multiple references is needed to make out a case of obviousness. The Examiner's rejection does not provide a basis for combining Swain and Boulanger in the manner that the Examiner proposes. Therefore, the Examiner's obviousness rejection of independent claims 1 and 18 should be withdrawn. Because dependent claims 2-17 and 19-33 contain all of the limitations of the independent claims upon which they depend, these claims are also allowable. Any other arguments that could be made in support of Applicant's dependant claims are unnecessary and would be superfluous at this time.

Conclusion

Applicant appreciates the Examiner's consideration of the remarks set forth above. None of the prior art of record discloses or suggests the combination of limitations in Applicant's claims. Thus, the claims are allowable. Accordingly, Applicant requests reconsideration and allowance of the application.

Respectfully submitted,



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